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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/731,651	12/07/2000	Jerry Walter Malcolm	AUS9-2000-0655-US1	9971
35525	7590	01/13/2009		
IBM CORP (YA) C/O YEE & ASSOCIATES PC P.O. BOX 802333 DALLAS, TX 75380			EXAMINER STORK, KYLE R	
			ART UNIT 2178	PAPER NUMBER
			NOTIFICATION DATE 01/13/2009	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ptonotifs@yeeiplaw.com

<b>Office Action Summary</b>	<b>Application No.</b> 09/731,651	<b>Applicant(s)</b> MALCOLM ET AL.	
	<b>Examiner</b> KYLE R. STORK	<b>Art Unit</b> 2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 31 and 32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 31 and 32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This non-final office action is in response to the RCE and amendments filed 3 November 2008.

2. Claims 31-32 are pending. Claims 1-9, 11-13, 15-16, 18-20, 22-24, and 26-30 are cancelled by the amendment. Claim 31 is independent.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maxwell et al. (US 6589290, filed 29 October 1999, hereafter Maxwell), and further in view of Pennell et al. (US 6910179, filed 9 November 1999, hereafter Pennell).

As per independent claim 31, Maxwell discloses a computer implemented method for automatically inserting a plurality of data into a standard compliant form to create a completed form comprising:

establishing a standard by defining a plurality of fields in a protocol extension to be used for construction of a plurality of standard compliant forms and for construction of a standard compliant data store (column 10, line 9- column 11, line 44: Here, the creation of a graphical representation of the dataset establishes a standard compliant data store. This data store may be used to populate standard compliant forms, such as forms that provide a data receptacle)

responsive to defining the plurality of fields, constructing the plurality of standard compliant forms and the standard compliant data store (column 12, lines 51-63)

at a first computer, transmitting the standard compliant form to the second computer over a network (column 12, lines 19-50)

at the second computer, responsive only to receipt of the standard compliant form, completing the standard compliant form (column 13, line 29- column 15, line 32)

wherein, upon receipt of the standard compliant form, a processor of the second computer invokes the standard complaint form and the data store and causes the standard compliant form to extract the plurality of data from the standard compliant data

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store to fill in all the fields in the standard compliant form (column 13, line 29- column 14, line 18)

Maxwell fails to specifically disclose storing data within a database. However, Pennell discloses storing form filling data in a database (column 2, line 61- column 3, line 6). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Pennell with Maxwell, since it would have allowed a user an organized method for storing user data.

6. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maxwell and Pennell, and further in view of Bertram et al. (US 5805159, patented 8 September 1998).

As per dependent claim 32, Maxwell and Pennell disclose the limitations similar to those in claim 31, and the same rejection is incorporated herein. Maxwell further discloses creating, a set of rules responsive to a flag included in the standard compliant form (column 12, line 51- column 13, line 28: Here, the data type required to fill a field acts as a flag. The data type indicates the appropriate data to use in order to fill a field), and another set of rules to make a decision when a conflict arises among one or more of the plurality of data (column 12, lines 51- column 13, line 28: Here, the conflict is resolved by placing the data having the appropriate data type into the form receptacle). Maxwell fails to specifically disclose a set of rules for combining the standard compliant form with the standard compliant database by applying a first set of rules for default values. However, Bertram discloses a set of rules for combining the standard compliant

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form with the standard compliant database by applying a first set of rules for default values (Abstract). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Bertram with Maxwell, since it would have provided a user with a set of default values to populate a form.

### ***Response to Arguments***

7. Applicant's arguments filed 3 November 2008, with respect to claim 31 have been fully considered but they are not persuasive.

The applicant's arguments focus upon the belief that the applicant's claim limitations perform the method of Maxwell more efficiently (pages 3-4). This is based upon the applicant's belief that unlike Maxwell, the applicant's claimed invention does not require a template file that resembles the form to be populated with data, and each form does not have to be found in the template file and have a description associated with a regular expression and a list of controls (page 4). However, it must be noted that the applicant's amended claim limitation does not preclude such steps from occurring. The applicant does not appear to argue that the combination of Maxwell and Pennell fail to teach the amended claim limitations; additionally, the examiner believes the combination does teach the limitations of claim 31. Therefore, absent some claim language that precludes such steps from being performed, the argument is not persuasive.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KYLE R. STORK whose telephone number is (571)272-4130. The examiner can normally be reached on Monday-Friday (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kyle Stork/

Kyle R Stork  
Primary Examiner  
Art Unit 2178

hrs